

### **Remarks**

Applicants have carefully reviewed the Office Action dated December 22, 2005.

Claims 1-65 are pending. Claim 7 has been withdrawn. Claims 1-6 and 8-57 have been rejected and claims 1, 4, 10, 25, 27, 37-41, 44, 45, 48 and 51 have been amended. Claims 29-36 have been cancelled. Claims 58-65 have been added.

#### **35 U.S.C. § 102 Rejection**

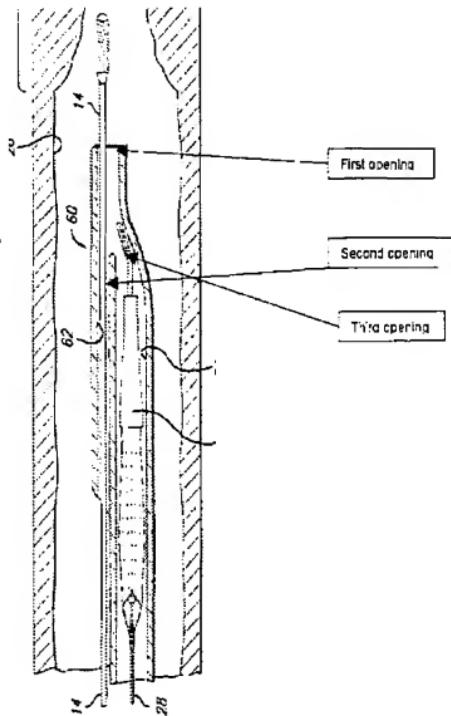
Claims 1-6 and 8-57 were rejected under 35 U.S.C. § 102(e) as being anticipated by Boyle et al., U.S. Patent No. 6,537,294 (hereinafter “Boyle”). Applicants respectfully traverse the rejection. In order for a reference to anticipate a claim, each and every element of the claim must be present in the reference. See M.P.E.P. §2131. Applicants assert that Boyle does not disclose each and every element of the claimed invention.

Boyle discloses a delivery system for embolic filter devices. As shown in Figures 7 and 8, the delivery system apparently comprises a delivery sheath 60 with a guidewire lumen 62 and a filter lumen 64. These two lumens appear to be in a side-by-side configuration. The two lumens apparently combine toward the distal end of the sheath and an opening appears to be formed at the distal end of the sheath.

In contrast, amended claim 1 recites, in part, a sheath comprising an elongate tubular member with a first opening from the lumen at the distal end of the tubular member and a second opening from the lumen proximal to the distal end. The openings define “points at which the lumen opens to an environment surrounding the sheath.” A guidewire passes through the first opening, through the lumen, and through the second

opening. A support wire extends through the lumen from proximal the second opening toward the distal end. Boyle does not appear to contain such structure.

In the Final Office Action, it was apparently asserted that the second opening can be located as shown in the following drawing, which has been copied from the Final Office Action:



However, the position marked "Second Opening" in the above figure cannot be described as an opening which defines a point "at which the lumen opens to an

environment surrounding the sheath," as required by amended claim 1. The second opening of the guidewire lumen of Boyle that does appear to be an opening which defines a point "at which the lumen opens to an environment surrounding the sheath" is at the proximal end of the guidewire lumen. In addition, the guidewire 28 of Boyle appears to extend down the filter lumen 64, along side the guidewire lumen 62.

There does not appear to be a lumen in Boyle that has a configuration allowing the passage of a guidewire and a support wire, as required by claim 1. For example, the guidewire lumen of Boyle does not have a guidewire passing through the first opening, the lumen and the second opening and a support wire extending through the lumen from proximal the second opening toward the distal end. Because Boyle does not contain at least these elements, Boyle cannot anticipate claim 1. In addition, because it recites similar structure, Boyle also cannot anticipate claim 10. Because they are dependent on claims 1 and 10 and because they contain additional patentably distinct elements, Applicants assert that claims 2-6, 8, 9, and 11-24 are patentable. Applicants also assert that newly added claims 58 and 59 are also allowable because they are dependent on claims 1 and 10 ad because they contain additional patentably distinct elements.

Further, Boyle does not disclose each and every element of claims 25 and 37. Claims 25 and 37 recite, in part, a sheath comprising an elongate tubular member that has a lumen. The sheath has a first opening from the lumen at a distal end of the tubular member. The sheath also has first and second outlet pathways having first and second exits, respectively. The exits define the point at which the first and second pathways open to an environment surrounding the sheath. The first exit is proximal the distal end

and the second exit is proximal the first exit and distal of the proximal end of the sheath. Boyle is missing at least this configuration of openings, outlet pathways and exits.

Boyle does not appear to have a lumen that has a first opening along with first and second exits as described in claim 25. Specifically, no lumen in Boyle has a first opening at the distal end of the sheath along with a first exit proximal of the distal end and a second exit proximal of the first exit and distal of the proximal end of the sheath. (Again, the exits of claim 1 define the points at which the first and second outlet pathways open to an environment surrounding the sheath.) Because Boyle does not disclose at least this portion of claim 25, Applicants assert that claim 25 is patentable over Boyle. Further, because claim 37 contains similar language, claim 37 is also allowable. Because they are dependent on claims 25 and 37 and because they contain additional patentably distinct elements, Applicants respectfully assert that claims 26-28 and 38-57 are also patentable over Boyle.

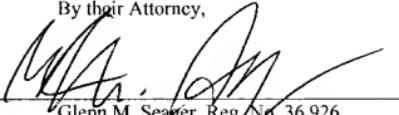
Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612-677-9050.

Respectfully submitted,

W. MARTIN BELEF ET AL.

By their Attorney,

Date: Feb. 16, 2006

  
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